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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 08/471,890      | 06/07/1995  | DONALD R. HUFFMAN    | 7913ZY              | 9010             |

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EXAMINER

HENDRICKSON, STUART L

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1754

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/471,890

Applicant(s)

HUFFMAN ET AL.

Examiner

Stuart Hendrickson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89-93 and 95-107 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 89-93, 95-107 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 89, 93, 107 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A) Claims 89 and 93 recite 'macroscopic' amounts of the material, but the original specification does not support this. The discussion on pgs. 5-8 of the prior office action (6/3/96) are referred to and incorporated.

Claims 90-92 and 95-106 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kroto/Nature November 14, 1985, with the Curl/Scientific American cited to show a state of fact.

Applicant is referred to the office action of 6/3/96, incorporated herein by reference.

Applicant's arguments filed ca. 2/22/05 have been fully considered but they are not persuasive. Prior arguments are incorporated herein by reference. Papers which are already of record should not be resubmitted. The 11/16/99 Kroto Declaration appears again. It is largely opinion that the claims are patentable. The Board has disagreed in prior proceedings, and the examiner disagrees as noted herein. It discusses various scientific experiments. It is not persuasive because it overlooks the fact that the '112 rejections are based upon what the specification says, rather than what could be done in a laboratory. The Moravsky 7/16/02 Declaration appears. Paragraph 11 discusses mechanism of formation. Even accepting it as correct, it is not relevant. Paragraph 12 discusses a 1998 reference on how to predict fullerene yield. This is irrelevant. Paragraph 13 also discusses this reference and is vague as to how 'close' the experiments were. The Loutfy Declaration of 7/16/02 appears again.

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There are no 'records' that the previous filing was a RCE, merely a misstatement in the previous action. The error is regretted and applicant's statements to this issue are accepted as correct. The Terminal Disclaimer is accepted and sufficient to overcome the rejection.

Arguments on pg. 9 to color are not persuasive, as a colored solution is referred to. It is possible that particles too small to be seen will nonetheless make a solution colored if their absorbance is strong and in the visible region. Kroto I-III addressed in previous proceedings (as were all the Declarations). Kroto III paragraph 17 is too vague, as it includes dates up to 1999 and does not shed light on the disclosure as originally filed. The thrust of Loutfy, that macroscopic amounts were inherently made, is noted and the examiner agrees that independent workers in this field-who would not appear to have any knowledge of the use of this term in the present application-have characterized the articles upon which this application is based as making macroscopic amounts of fullerene. However, the Board has ruled that this is not supported (if only because it is not defined) in prior proceedings, incorporated herein by reference.

Kroto/Nature does not reject the 'macroscopic' claims. The Kratschmer rejection is withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number ~~(703) 308-2539~~. **571-272-1351**.



Stuart Hendrickson  
Primary examiner Art Unit 1754